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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,492	01/31/2001	Daniel J. Graney	P/12-839	3104

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 04/10/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,492

Applicant(s)

GRANEY, DANIEL J.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The objection to claims 5 and 9 is withdrawn. The 112 2nd paragraph rejection over the terms “very”, “generally”, and “substantially” are withdrawn because the claim has been amended to provide clarity to the indefinite aforementioned terms. All other 112 2nd paragraph rejections are withdrawn. The 103 rejection is withdrawn.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,451,449 to Shetty et al. in view of USPN 6,459,514 to Gilbert et al. and USPN 6,340,525 to Akamatsu et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

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disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Claims 1-9 directed to an invention not patentably distinct from claims 1-9 of commonly assigned U.S. Patent No. 5,451,449 to Shetty et al.

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,451,449 to Shetty et al. in view of USPN 6,459,514 to Gilbert et al. and USPN 6,340,525 to Akamatsu et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims an uniaxial oriented multilayered film, while the Shetty reference claims a film that has not been oriented uniaxially having a mechanical property ultimate tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2), thickness of 0.007-0.034 mm, and thread width of 0.15 to 0.33 mm (claim 9). However, it would have been obvious to one of ordinary skill in the art to claim an uniaxial oriented multilayered film having a mechanical property ultimate tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) since Gilbert teaches it is known to uniaxially stretch/orient a coextruded multilayered iridescent film. A multilayered iridescent film having tensile at break being 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) is optimizable. Especially since the film has the same thickness as Applicant claims. The same

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film thickness is *claimed* in Shetty. Stretching the film of Shetty will produce the tensile at break property as in the instant application because tensile at break is effected by the stretch ratio and thickness of a film. Furthermore, stretching films are varied to produce the desired refractive index as taught by Gilbert at col. 5, lines 10-20 and col. 7, lines 1-3. Hence it would have been obvious to one of ordinary skill in the art to modify the film of Shetty where a multilayered iridescent film has a tensile at break of 2.5 to 9 kgf and/or 4.5 to 7 kgf (claim 2) since it has been held that experimental modification of the prior art in order to ascertain optimum operating conditions (e.g. stretch ratios, temperatures, speed of the tensile gauges, or other process variables that effect mechanical properties such as tensile strength/tear) fails to render Applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

Regarding claims 3 and 6, Shetty teaches the refractive index is at least about 0.06. See patented claim 6 and col. 3, lines 35-39. Also regarding the amount of multilayers being at least 35 in instant claims 3 and 6, see patented claim 4.

Regarding claims 4 and 7, the film being a terephthalate is claimed, see patented claim 7.

Regarding claim 5 and 8, the only difference is that the contiguous adjacent layer is a thermoplastic elastomer. An elastomer is well known in the art to use since Gilbert teaches elastomers are suitable to use in coextruded films in the skin layers at col. 5, line 61. Gilbert teaches polybutadiene as a specific suitable resin. Hence it would have been obvious to one of ordinary skill in the art to modify the uniaxial oriented film of Shetty to include an elastomer since Gilbert teaches elastomers can be used to protect the inner/base layers at col. 11, lines 20-50.

Regarding claim 9, Patent '499 differs only in that it is not formed in a microfilament having a width of 0.15 to 3 mm. However, Akamatsu teaches a microfilament may be formed by

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using a melt-spinnert at col. 4, line 60. A microfilament may also be formed from extruding procedures as in Example 2 using PET. Hence it would have been obvious to one of ordinary skill in the art to modify the film of Shetty to produce a microfilament since Akamatsu teaches a microfilament may be formed by using a melt-spinnert at col. 4, line 60 and also from extruding procedures as explained in Example 2 of Akamatsu for the purpose of increasing the mechanical strength, using such microfilament in yarn or cords at col. 1, lines 10-35 and col. 5, lines 1-25. In regards to the Ouderkik reference, this reference is not and has not been relied upon in any rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,759,467 to Carter et al. teaches a method for making multilayer polyester films and tensile properties.

Response to Argument

In response to Applicant's contention regarding the traversal of the restriction requirement involving the method of making the product, producing a multilayer film via co-extrusion may be performed by a different method such as individually extruding each film and then combine them together or by utilizing tubular processes. A restriction is proper when the groups are independent and distinct. This has been shown by proving the multilayer film may be made by a different method. The restriction traversal has been considered. Withdrawal of the restriction requirement is denied.

Regarding Applicant's contention that the Shetty reference does not show the ultimate tensile at break and the optimizable properties are not optimizable, the Examiner does not agree. The Shetty reference teaches the exact same materials, and thickness range of 30 to 500 nm.

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Since the thickness range and materials are used, the fact that Applicant now decides to perform testing methods using an Instron tester, which yields ultimate tensile at break is very much so optimizable. The stress vs. strain curve and equation Instron uses to derive the ultimate tensile at break, **will not** change if the exact same materials and thickness of the testing film specimen stays consistent with the instant application. The exact same materials and thickness are used and since the Applicant has not shown any evidence to the contrary, the Shetty reference is relied upon as there is basis for using this reference.

In response to Applicant's argument that the Akamatsu reference does not show a multilayered structure is true. However, Akamatsu is only used to show that a film can be formed into a microfiber. There is nothing novel about this process. Simply changing the width of a film to produce a smaller film width which Applicant calls a "microfilament" is certainly optimizable. Especially since a film can easily be made into a microfiber by simply changing the dye on the machine used to produce the film/filament, which is usually an extruder, or cut, which is equivalent to the instant application explaining the film is slit. The same polymeric material, thickness, and multilayer structure is present, the compatibility of the inner adhesion of the film will not change from layer to layer, so the film would be expected to still show compatibility and not break apart to allow a film to be slit into filaments. Furthermore, Applicant admits in the response that the rheological and thermomechanical properties of individual polymers are inherent. The Examiner does not use Akamatsu to show use of a monolayer terephthalate film as Applicant contorts. The Akamatsu reference is used to show the aforementioned and explained procedures are well-known to change a film, be it multilayer or monolayer, to make a filament. See Figure 4 and the Examples, which explicitly explain how to produce a filament. Moreover when refuting a 103 obviousness rejection, one cannot show nonobviousness by attacking

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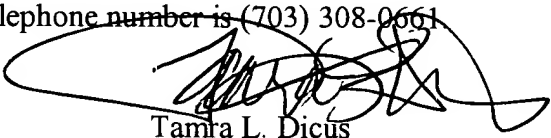
references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

April 4, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
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